

## **REMARKS**

This application has been reviewed in light of the Final Office Action mailed April 21, 2005. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1, 3, 5-18, 20-21 and 23-29 are currently pending with Claims 1, 3, 6, 7, 8, 11, 16, 18, 23, 24, 25, 26, 28 and 29 being in independent form. Claims 1, 6-7, 11-15, 23-24 and 26-17 have been previously withdrawn. By the present amendment, Claims 38, 9, 16, 18 and 25 have been amended. No new subject matter or issues have been introduced by way of the present amendment.

Initially, Applicant had previously submitted Claims 28 and 29 in a Supplemental Amendment dated January 24, 2005. However, as of the mailing date of the present Final Office Action of April 21, 2005, these claims had not been made of record by the U.S. Patent Office. After speaking at length with both the Examiner and his supervisor, it seems that the Supplemental Amendment was lost or misplaced by the Patent Office. Therefore in accordance with the agreement reached in the interview with the Examiner on June 8, 2005, Applicant has agreed to respond to the present Final Rejection with a mention of the missing claims, a copy of the Supplemental Amendment and postcard receipt as proof of mailing on January 24, 2005 and subsequent receipt of the amendment by the Patent Office. The Examiner has stated that he will consider Claims 28 and 29 at that time and issue a NON-FINAL Office Action covering all the pending claims at that time, thereby avoiding any penalty to the Applicant due to the Patent Office having failed to properly handle the Supplemental Amendment.

It should be noted that Claims 28 and 29 recite similar language as Claims 3, 8, 16, 25, regarding “comparing step” and “means for comparing”, respectively. Therefore, the reasons presented below regarding the patentability of Claims 3, 8, 16 and 25 also apply to Claims 28

and 29. Accordingly, Claims 28 and 29 are believed to be patentably distinct and allowable over the prior art references.

**I. Rejection of Claims 3 and 25 Under 35 U.S.C. §102(e)**

Claims 3 and 25 have been rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 5,940,761 issued to Tiedemann, Jr. et al. Claims 3 and 25 have been amended in a manner believed to place these claims in condition for allowance.

Tiedemann, Jr. et al. teaches a method for performing mobile assisted hard handoff between communication systems having a system preference table. However, Tiedemann, Jr. et al. does not disclose or suggest comparing a first list having at least one unique network identifier and received by a User Equipment from an active network, against a second list, internally stored in the User Equipment, which includes the at least one unique network identifier, as recited in Applicant's amended Claims.

Specifically, Claim 3 recites: "A method of facilitating handover from an active network with which User Equipment is in communication to another network, the method comprising the steps of: transmitting to the User Equipment a first list having at least one unique network identifier, comparing the first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the User Equipment; receiving from User Equipment communicating via the active network an indication of at least one preferred other network selected from the plurality of networks in the comparing step; and in response thereto, providing to the User Equipment via the active network neighbor cell information for the at least one preferred other network." (Emphasis added). Claim 25 recites similar relevant limitations.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, it is not reasonably possible for Tiedemann, Jr. et al. to anticipate Applicant’s invention as recited in Claims 3 and 25, as Tiedemann, Jr. et al. fails to explicitly teach, or inherently suggest, all the claimed limitations of Applicant’s Claims 3 and 25 arranged as required by the claims. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 3 and 25 under §102(e) over Tiedemann, Jr. et al.

## **II. Rejection of Claims 16-19 Under 35 U.S.C. §102(e)**

Claims 16-19 have been rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 6,223,030 issued to Van Den Heuvel et al. Claim 19 was previously canceled and thus the rejection with respect to Claim 19 is moot. Claims 16 and 18 has been amended in a manner believed to place these claims in condition for allowance.

Van Den Heuvel et al. teaches a communications operating system for mobile phones, however Van Den Heuvel et al. does not disclose or suggest a means for performing a handover from an active network with which a mobile device is in communication to another network. Nor does Van Den Heuvel et al. disclose or suggest a means for comparing a first list received by a User Equipment from an active network, against a second list, internally stored in the User Equipment, as recited in amended Claims 16 and 18.

Specifically, Claim 16 recites: “User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising: means for receiving a first list from the active network, the first list having at least one unique network identifier; means for storing a second list of available other networks supplied by the active network; means for comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks; and means for transmitting from the User Equipment an indication of a preference for a network.” (Emphasis added). Claim 18 recites similar relevant language as that highlighted in Claim 16.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, it is not reasonably possible for Van Den Heuvel et al. to anticipate Applicant’s invention as recited in Claims 16 and 18, as Van Den Heuvel et al. fails to explicitly teach, or inherently suggest, all the claimed limitations of Applicant’s Claims 16 and 18 arranged as required by the claims. Additionally, Claim 17 depends from Claim 16 and thus is limited by the limitations recited in Claim 16. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 16-18 under 35 U.S.C. §102(e) over Van Den Heuvel et al.

### **III. Rejection of Claims 5 and 8-10 Under 35 U.S.C. §103(a)**

Additionally, Claim 5 has been rejected under 35 U.S.C. §103(a) for allegedly being obvious over Tiedemann, Jr. et al. in view of U.S. Patent No. 6,272,315 issued to Chang et al., and Claims 8-10 have been rejected under 35 U.S.C. §103(a) over Van Den Heuvel et al. in view of Chang et al.

Chang et al. discloses a mobile satellite system and terrestrial wireless system interworking technique for switching a mobile unit between a mobile satellite system mode and a terrestrial wireless system mode. Additionally, Chang et al. teaches adding a system ID of a network to the bottom of a list of system IDs stored in a memory of a mobile terminal.

However, Chang et al fails to disclose or suggest subtracting a system ID from the list based on information supplied by the active network with which the User Equipment is in communication as recited in Claim 8. Further, Chang et al. fails to disclose or suggest receiving a first list having at least one unique network identifier; storing a preference for a network in a second list having the at least one unique network identifier and is internally stored in the User Equipment; comparing the received first list with the second list for selectively communicating with at least one of a plurality of networks as recited in Claims 3, 8 and 16.

Tiedemann, Jr. et al. and Chang et al., and separately, Van Den Heuvel et al. and Chang et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's invention as recited in Claims 3, 8, 16 and 25.

Claims 5 and 9-10 depend from Independent Claims 3 and 8 and thus include the limitations recited in those independent claims. Therefore, for at least the reasons given above regarding Claims 3, 16 and 25, Claims 5 and 8-10 are believed patentably distinct over the prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 5 under 35 U.S.C. §103(a) over Tiedemann, Jr. et al. in view of Chang et al.,

and the rejection with respect to Claims 8-10 under 35 U.S.C. §103(a) over Van Den Heuvel Jr. et al. in view of Chang et al.

#### **IV. Rejection of Claim 21 Under 35 U.S.C. §103(a)**

Claim 21 has been rejected under 35 U.S.C. §103(a) over Van Den Heuvel et al. in view of U.S. Patent No. 6,584,116 issued to Gourgue et al. Claim 21 depends from Independent Claim 16 and thus includes the limitations recited in that independent claim.

Gourgue et al. discloses a UMTS network and a GSM network, and a method of handover to a GSM network from a UMTS network during a call originating in a UMTS network. However, Gourgue et al. fails to overcome the deficiencies present in Van Den Heuvel et al. with respect to limitations recited by Claim 16. Specifically, Gourgue et al. fails to disclose or suggest "...means for receiving a first list from the active network, the first list having at least one unique network identifier; means for storing a second list of available other networks supplied by the active network; means for comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks..." as recited in Claim 16.

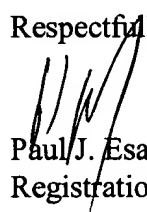
Therefore, for at least the reasons given above regarding 16, Claim 21 is believed patentably distinct over the prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 21 under 35 U.S.C. §103(a) over Van Den Heuvel Jr. et al. in view of Gourgue et al.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3, 5, 8-10, 16-17, 18, 20-21, 25, and 28-29 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Examiner:** Huy Q. Phan

**U.S. Serial No:** 09/589,217

**Art Unit:** 2687

**Filed:** June 7, 2000

**Docket:** 13665

**For:** HANDOVER BETWEEN MOBILE  
COMMUNICATION NETWORKS

**Date:** January 24, 2005

**Confirmation No.:** 8681

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL AMENDMENT**

Sir:

Applicant respectfully requests under the provisions of 37 C.F.R. § 1.111 that the above-identified Application be amended as follows and that the Application be allowed.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 24, 2005.

Dated: January 24, 2005

\_\_\_\_\_  
George Brieger



## **LISTING OF THE CLAIMS:**

*The following listing of claims replaces all prior versions and listings.*

**Claim 1. (Withdrawn)** A method of facilitating handover from an active network with which User Equipment is in communication to another network, the method comprising the steps of:

providing a list of available other networks to said User Equipment via the active network;

in the User Equipment, selecting among the available networks based on preference information and signaling to said active network at least one preferred other network; and

providing neighbor cell information for the at least one preferred other network to said User Equipment via the active network.

### **Claims 2. Cancelled**

**Claim 3. (Previously Presented)** A method of facilitating handover from an active network with which User Equipment is in communication to another network, the method comprising the steps of:

receiving from User Equipment communicating via the active network an indication of at least one preferred other network; and

in response thereto, providing to the User Equipment via the active

network neighbor cell information for the at least one preferred other network.

**Claim 4. Cancelled**

**Claim 5. (Previously Presented)** A method according to claim 3 further comprising a step of incrementally adding to or subtracting from the list of available networks.

**Claim 6. (Withdrawn)** A method of facilitating handover from an active network with which User Equipment is in communication to another network, the method comprising:

providing to User Equipment communicating via the active network a list of available other networks; and

sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks.

**Claim 7. (Withdrawn)** A method of operating an active network to facilitate handover to another network comprising:

maintaining a connection via the active network with a User Equipment; and

a step of providing to the User Equipment communicating via the active network a message containing information for incrementally adding to or subtracting

from a stored list of available networks.

**Claim 8. (Previously Presented)** A method of operating User Equipment capable of handover between an active network and another network comprising:

storing a preference for a network; and

a step of incrementally adding to or subtracting from a stored list of available networks based on information supplied by the active network with which the User Equipment is in communication.

**Claim 9. (Previously Presented)** The method of claim 8 comprising:

a step of signaling to the active network with which the User Equipment is in communication the preferred other network for handover.

**Claim 10. (Original)** A method according to claim 9, wherein said preferred other network is selected by the User Equipment from a list of available networks supplied by the network.

**Claim 11. (Withdrawn)** A method of operating an active network with which User Equipment is in communication comprising:

maintaining a connection via the active network with a User Equipment;

and

a step of sending neighbor cell information to User Equipment based on network preferences communicated by the User Equipment.

**Claim 12. (Withdrawn)** A method according to claim 11 comprising a step of sending mutually different neighbor cell information to mutually different User Equipments based on mutually different network preferences.

**Claim 13. (Withdrawn)** A method according to claim 1, wherein the preferred other network is selected based on information stored in the User Equipment, preferably in a SIM card.

**Claim 14. (Withdrawn)** A method according to claim 1, wherein the active network is a UMTS network and the other network is selected from available GSM networks.

**Claim 15. (Withdrawn)** A method according to claim 1, wherein the active network is provided by an active network provider and the other network is selected from networks provided by other network providers.

**Claim 16. (Previously Presented)** User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising:

means for storing a list of available other networks supplied by the active network; and

means for transmitting from the User Equipment an indication of a preference for a network.

**Claim 17. (Original)** User Equipment according to claim 16, further comprising means for updating the stored list of available other networks based on information supplied by the active network.

**Claim 18. (Previously Presented)** User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising:

means for updating a stored list of available other networks based on information supplied by the active network; and

means for transmitting from the User Equipment an indication of a preference for a network.

**Claim 19. Cancelled**

**Claim 20. (Previously Presented)** User Equipment according to claim 18, further comprising means for storing network preference information.

**Claim 21. (Original)** User Equipment according to claim 16, wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks.

**Claim 22. Cancelled**

**Claim 23. (Withdrawn)** A mobile communications network or component thereof comprising:

communicator configured to communicate to User Equipment communicating with the network a list of available other networks; and means for sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks.

**Claim 24. (Withdrawn)** A mobile communications network or component thereof including:

means for maintaining a connection via the active network with a User Equipment; and means for sending a message to the User Equipment containing information for incrementally adding to or subtracting from a list of available networks stored in the User Equipment.

**Claim 25. (Previously Presented)** A mobile communications network or

component thereof including:

means for receiving from User Equipment communicating with the network an indication of a preferred other network; and

means for supplying neighboring cell information for the preferred other network based on the indication.

**Claim 26. (Withdrawn)** A mobile communications network or component thereof including:

maintaining a connection via the active network with a User Equipment; and

means for sending neighbor cell information to the User Equipment based on network preferences communicated by the User Equipment.

**Claim 27. (Withdrawn)** A mobile communications network or component thereof according to claim 26 arranged to send mutually different neighbor cell information to mutually different User Equipments based on mutually different network preferences.

**Claim 28. (New)** A method of using user equipment for a mobile communication system comprising:

receiving a first list including at least one unique network identifier; and  
comparing the received first list with a second list which includes the at

least one unique network identifier and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks.

**Claim 29. (New)** User equipment for a mobile communication system comprising:

means for receiving a first list including at least one unique network identifier; and

means for comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks.



### REMARKS

New claims 28 and 29 are added. Therefore, claims 1, 3, 5-18, 20, 21 and 23-29 are presently pending in the above-captioned Application.

Claims 1, 6, 7, 11-15, 23, 24, 26 and 27 are withdrawn pursuant to the restriction requirement. Therefore, claims 3, 5, 8-10, 16-18, 20, 21, 25, 28 and 29 are the claims presented for prosecution at this time.

Newly added claims 28 and 29 are fully supported by Applicant's disclosure. By way of example, see the description at page 15, line 7 - page 16, line 23. Claims 28 and 29 are within the scope of Invention II.

Should the Examiner have any questions about the within Amendment, or about the Application more generally, the Examiner is invited to telephone the undersigned attorney at the telephone number listed below.

Respectfully submitted,

  
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